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AUG 23 1972
MICHAEL RODAK, JR., CLERK

In the

Supreme Court of the United States

OCTOBER TERM, 1971

SKIL CORPORATION,

Petitioner,

vs.

LUCERNE PRODUCTS, INC.,

Respondent.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

CLARENCE J. FLEMING
135 South LaSalle Street
Chicago, Illinois 60603
Tel.: (312) 346-0338
Attorney for Petitioner

Of Counsel:
MARC L. SWARTZBAUGH
1750 Union Commerce Building
Cleveland, Ohio 44115
Tel: (216) 696-3939
CHARLES M. CARTER
5033 North Elston Avenue
Chicago, Illinois 60630
Tel.: (312) 286-2000

The Scheffer Press, Inc.—(312) 263-6850

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In The

SUPREME COURT OF THE UNITED STATES

October Term, 1971

No. 72-1282

SKIL CORPORATION,

Petitioner,

vs.

LUCERNE PRODUCTS, INC.,

Respondent.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Respondent Has Not Addressed Itself to the Questions Set Forth in the Petition

The respondent's brief is evasive as it plainly does not respond to the questions presented in the petition for a writ of certiorari. Moreover, the issues set forth by respondent are not only wide of the mark, they are inaccurate.

Issue (1) implies an identity of parties and issues between the Cleveland and Chicago actions. As detailed in our petition, this is certainly not the case. Further, the February 29 restraining order prevents the petitioner from proceeding in the Chicago action in its entirety and

not just with respect to certain issues as contended by the respondent.

As to respondent's Issue (2), there is absolutely no support in the record for the statement that previous rulings have estopped petitioner from prosecuting the Chicago action against the direct infringers, the manufacturers of the accused drills. This contention is sheer nonsense — even respondent's reference to the transcript of proceedings before Judge Will (RB 13)[1] belies its assertion in this respect.

Regarding Issue (3), nothing in the respondent's brief militates in any way against the showing in our petition that the District Court committed grave errors in enjoining the Chicago action and that the Court of Appeals, in affirming, has sanctioned a departure from the accepted and usual course of judicial proceedings to a degree requiring corrective action by this Court.

Inaccuracies in Respondent's Statement of the Case

We believe it is incumbent upon us to point out at least the more glaring misstatements of the respondent in order to permit this Court to consider the petition against an accurate and fair presentation of the background facts.

As already mentioned, *supra*, Judge Will has entered no order prohibiting petitioner from protecting its Gawron patent by the filing of the suit against the direct infringers, Rockwell and Wen. Further, the transfer rulings of Judges Will and Green referred to by respondent are of no

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[1] References to the respondent's brief in opposition are in the form "(RB 13)".

moment to the issues now presented as such rulings occurred *prior* to cancellation of the Gawron license and institution of the Chicago action.

Nothing in the record supports respondent's statement that the Cleveland action will be tried in the Fall term. On the other hand, the record is abundantly clear that the Chicago action had a trial date setting of March 27, 1972 (AL 12) and would have gone to trial on or about that date, but for the February 29 restraining order.

In an endeavor to avoid the important contributory infringement damage issue this petition has presented in the light of *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 377 U.S. 476 (1964), respondent would have this Court believe it occupies the same position as Rockwell and Wen with respect to infringement of the Gawron patent. Petitioner's patent (Pet. 12a)[2] clearly covers the drills manufactured by Rockwell and Wen as claim 4, for example, recites ". . . a hand manipulatable power drill . . ." Respondent supplies the switches for these drills (AL 7, page 2) and consequently occupies the role of a contributory infringer only.

With regard to transfer of the Chicago action, respondent never even moved to transfer that case in its entirety to Cleveland — it alone moved (Rockwell and Wen did not join in the motion) to transfer only as to Counts II and III, the so-called Gawron license counts. The order of transfer (RB 18) was the result of a clerical error by Judge Hoffman as clearly indicated by his comments from

[2] References to the petition for a writ of certiorari are in the form "(Pet. 12a)".

the bench on November 19, 1971.[3] This transfer order was promptly vacated by Judge Hoffman on November 22, 1971.[4]

Respondent Offers No Real Reasons Why the Writ Should Not Issue

The respondent's "reasons" in opposition to the petition are so unpersuasive that they do not warrant a reply on the merits herein. We need only comment briefly on three points in the interest of correcting statements made by respondent.

First, as we have already shown, there is no identity of subject matter or products between the Cleveland and Chicago areas. In the Cleveland action, the only products in issue are the switch devices of the respondent; in the Chicago action wherein the additional parties, Rockwell and Wen, are present, the accused devices are the drills manufactured by these two defendants.

Second, as concerns the chronology involved in the entry of the orders by Judges Lambros and Hoffman, the point is that Judge Lambros telephoned Judge Hoffman and discussed the issue as to whether or not the Chicago case should be stayed.[5] Judge Hoffman was in the better position to determine whether or not the case

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[3] A copy of the transcript of this proceeding is attached as Exhibit B to Skil Corporation's Petition for Rehearing in the Court of Appeals. We also invite this Court's attention to that petition for rehearing.

[4] This order is reproduced in the appendix to this brief at page 1a.

[5] See Exhibits A and E to Motion of Plaintiff-Appellant for Expediting Appeal Pursuant to the Provisions of Rule 2 of the Federal Rules of Appellate Procedure.

before him *i.e.*, the Chicago action, should have gone forward — he ruled orally on February 29 that the Chicago action should be promptly tried (Pet. 6a). Judge Lambros, in the interest of comity, should not have interfered — Judge Hoffman gave full and proper consideration to the respondent's motion to stay the Chicago action.

Third, respondent cannot prop-up the February 29 order by referring to the rulings of Judges Will and Green, all of which rulings were entered prior to cancellation of the Gawron patent license and filing of the Chicago action. Moreover, nowhere in the February 29 order (Pet. 4a) is reference made to any of these prior rulings.

Conclusion

We have set forth in our petition three principal reasons for issuance of a writ of certiorari. The respondent has refused to address itself to the important questions presented by the petition — respondent has remained completely silent as concerns the contributory infringement damage question which is now ripe for disposition. Lacking any real basis on which to oppose issuance of the writ, respondent has engaged only in name-calling and in the making of inaccurate statements. Clearly, the writ should issue for the reasons set forth in our petition and in this reply brief.

Respectfully submitted,

CLARENCE J. FLEMING
135 South LaSalle Street
Chicago, Illinois 60603
Tel.: (312) 346-0338
Attorney for Petitioner.

Of Counsel:
MARC L. SWARTZBAUGH
1750 Union Commerce Building
Cleveland, Ohio 44115
Tel.: (216) 696-3939
CHARLES M. CARTER
Chicago, Illinois 60630
5033 North Elston Avenue
Tel.: (312) 286-2000

APPENDIX

UNITED STATES DISTRICT COURT
Northern District of Illinois
Eastern Division

Name of Presiding Judge, Honorable Julius J. Hoffman
Cause No. 70 C 2858 Date November 22, 1971

Skil Corporation v. Rockwell Manufacturing Company and Wen Products, Inc. v. Lucerne Products, Inc.

The motion of plaintiff for entry of an order clarifying minute order of October 29, 1971 re motion of defendant Lucerne Products, Inc. to dismiss, etc. and for vacating such order as concerns transfer is allowed.

The order of October 29, 1971 transferring this cause to the Northern District of Ohio, Eastern Division is vacated. The order of October 29, 1971 denying the motion of the defendant, Lucerne Products, Inc., to dismiss Counts I and II of the amended complaint is vacated. The motion of the defendant, Lucerne Products, Inc., to dismiss Counts II and III of the amended complaint is denied; defendant, Lucerne Products, Inc., is ordered to file its answer to these two counts within twenty days. The motion of defendant, Lucerne Products, Inc., for an injunction is denied. The motion of defendants, Lucerne Products, Inc., for an award of reasonable attorney's fees is denied.